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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,706	11/18/2003	Roland J. Koestner	84801AEK	5399

7590

05/22/2006

Paul A. Leipold  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/715,706

Applicant(s)

KOESTNER ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 20-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 3/31/2006. Applicants' amendments to claims 1 and 17 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Election/Restrictions***

4. Applicant's traversal in the reply filed on 3/31/2006 is acknowledged. The traversal is on the ground(s) that "... It is not seen how the film of claim 1 and of claim 17 are independent and distinct ... since claim 1 is clearly generic to claim 17 ... Claim 1 does not exclude a transparent polymeric support ... since it is a comprising claim ...". This is not found persuasive, while claim 1 is a comprising claim, the Examiner repeats that since claim 1 does not require a transparent polymeric support, as set forth in claim 17, claim 1 and its dependent claims are structurally distinct and independent from the film species of claim 17. In particular, Applicants are reminded that the specification clearly discloses that the optical film of claim 1 can be a free-standing film (see specification, page 12, line 22), which does not require a support film. As such, the Examiner asserts that claims 1 and 17 are directed to structurally independent and distinct inventions, and if the support is an essential element of elected species, the

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absence of such limitation in claim 1 and its dependent claims renders them either as non-elected species, or not enabling under USC 112, first paragraph, because it lacks a critical or essential element to the practice of the invention.

With respect to Applicants' argument "... Applicants elected the binder species of claim 6 but Examiner has withdrawn claim 6 ...", the Examiner notes that since claim is a dependent claim, it is withdrawn with independent claim 1 together. The Examiner suggests that if Applicants desire, the limitation of claim 6 can be amended to be dependent upon claim 17, or by adding a new claim having the same limitation, but to be dependent upon claim 17.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Saitou et al. (US 2003/0180520) in view of JP 53-140338 (Derwent abstract).

First, the Examiner repeats the relied upon prior art Saitou as follows: Saitou's invention is directed to a transparent anti-glare hard coat film formed on at least one surface of a transparent polymer film, the transparent hard coat layer is composed of inorganic micro-particles uniformly dispersed in an ionizing radiation curable organic

binder, and the inorganic micro-particles having a mean particle diameter of 1-10  $\mu\text{m}$ .

The organic-inorganic hybrid hard-coat agent preferably contains reactive silica (abstract and paragraph 0008). Examples of the inorganic particles include porous silica, etc. (paragraph 0031). Suitable transparent polymer film include triacetyl cellulose film, etc. (paragraph 0015). Finally, it should be noted that the specific surface area of a particle is inherently proportional to its diameter, and silica is inherently an inorganic polymer.

With respect to Applicants' argument, referring to newly amended claim 1, "... Saitou ... use of inorganic porous silica particles ... the present invention, as now amended, is directed to preformed porous organic polymer particles ...", it is noted that JP '338 is directed to an anti-glare coating composition, and JP '338 expressly teaches that the coating composition comprises urethane type resin and inorganic or organic particles (abstract). As such, in the absence of unexpected results, it would have been obvious to substitute the inorganic particles of Saitou with suitable organic particles, as taught by JP '338. It should be noted that the selection and substitution of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Finally, regarding the specific surface area and diameter of the particles, the Examiner notes that since the combined teachings of Saitou and JP '338 are directed to the same subject matter (a porous particle/binder coating composition) and for the same use (anti-glare) as the instant invention, the utility as such dictates there would be similar physical properties, it is the Examiner's position that, in the absence of unexpected results, these physical

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properties are obvious optimizations to one skilled in the art of anti-glare coating. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

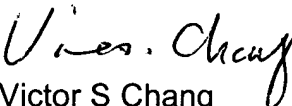
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

5/8/06